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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,157	10/17/2001	William R. Perrault	28341/6301A.US	7525

4743 7590 03/20/2003

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EXAMINER

SHAMEEM, GOLAM M

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 03/20/2003

Docketed: 4-20-03

Please find below and/or attached an Office communication concerning this application or proceeding.



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OFFICE OF PETITIONS

**Office Action Summary**

Application No.

09/982,157

Applicant(s)

PERRAULT ET AL.

Examiner

Golam M M Shameem

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This office action supersedes the previous office action of paper No. 8 which has been entered in the file.

#### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 drawn to a compound (alcohol) of a formula, classified in class 568 with several subclasses.
- II. Claims 7-12 drawn to a compound (ester) of a formula, classified in class 558 with several subclasses.
- III. Claims 13-16 drawn to drawn to a compound (epoxide) of a formula, classified in class 549 with several subclasses.
- IV. Claims 17 and 20-22 drawn to an intermediate compound of a formula, classified in class 548 with several subclasses.
- V. Claims 18-19 drawn to an intermediate compound of a formula, classified in class 548 with plethora of subclasses.
- VI. Claims 23-25 drawn to a method of preparing a secondary alcohol of a formula, classified in class 568 with several subclasses.
- VII. Claims 26-28 drawn to a method of preparing a secondary ester of a formula, classified in class 558 with several subclasses.
- VIII. Claims 29-31 drawn to a method of preparing an epoxide of a formula, classified in class 549 with several subclasses.

- IX. Claims 32-33 and 36-40 drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.
- X. Claims 34-35 drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.
- XI. Claims 41-42 and 45-48 drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.
- XII. Claims 43-44 drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.
- XIII. Claims 49-50 and 53-56 drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.
- XIV. Claims 51-52 drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.
- XV. Claims 57 drawn to a compound of a formula, classified in class 548 with several subclasses.
- XVI. Claim 58 drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

The above groups are identified as general areas. The inventions are distinct, each from the other because of the following reasons:

Invention Groups I-XVI are related as compounds, their process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product can be made by another materially different process (MPEP 806.05(f)). In the instant

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case, the process as claimed can be made at least one materially different product as demonstrated throughout the specification. The products of groups I and XVI differ materially in structure and in element and the process of groups VI-XIV and XVI are distinct because each process has different reactive steps and conditions. Also the fields of search are not coextensive. Therefore a separate search considerations are involved, which would impose a burden if unrestricted. Additionally, besides performing a class/subclass search, the examiner performs a commercial data base search and an automated patent system (text) search.

The products of groups I-V differ materially in structure and in element. The invention Groups I-V outlined above each relate to a set of structurally diverse and dissimilar compounds which do not possess a substantial common core wherein a reference anticipating one would not necessarily render the other obvious and to search all the above groups in a single application would be an undue burden on the Examiner.

The above groups themselves are inclusive of patentably distinct subject matter. Accordingly, along with the election of one of the above groups, the following action is also taken.

Invention groups such as V, X, XII and XIV comprising claims which are generic to a plurality of disclosed patentably distinct species and applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

Upon the election of a single disclosed species (e.g. Example, page number and structural depiction), a generic concept, inclusive of the elected species, will be identified by the Examiner for examination along with the elected species. Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon.

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

In accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with method of use claims commensurate in scope with the allowed product claims will occur following a finding that the product claims are allowable. Until such time, a restriction between product claims and process/use claims is deemed proper.

Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised the process of use are amended during prosecution to maintain either dependency on the product claims or to otherwise include limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

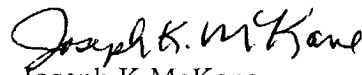
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is 703-305-0116. The Examiner can normally be reached on 8:30AM-5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 703-308-4537. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7921 for regular communications and 703-308-7921 for after final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Golam M M Shameem, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1

  
Joseph K McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1

March 19, 2003